

REMARKS

Claims 22, 23, 25 and 26 are canceled without prejudice, and therefore claims 19 to 21, 24, and 27 to 37 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to paragraph ten (10) of the Office Action, Applicants thank the Examiner for indicating that claims 32 and 36 contain allowable subject matter. The objections are respectfully traversed, however, since it is respectfully submitted that claims 19 to 21, 24, 26 to 31, 33 to 35 and 37 are allowable as explained herein. It is therefore respectfully requested that the objections be withdrawn since claims 32 and 37 depend from allowable claims, as explained herein.

With respect to paragraph three (3), the drawings were objected to in the Office Action. While the objections may not be agreed with, to facilitate matters, claims 22, 23 and 25 (the Office Action wrongly referred to claim 26, rather than claim 25) have been canceled without prejudice. As to claim 24, it has been rewritten, and it is respectfully submitted that a circle is only a special form of the elliptical equations, that the elliptical shaped discs are disclosed in the specification to a person having ordinary skill in the art, and that it is not necessary to show this aspect in the drawings since it is not necessary to understanding the claimed subject matter. Accordingly, the objection to the drawings is respectfully traversed in this regard since the drawings were objected to under 37 C.F.R. § 1.83(a) ("Rule 83(a)"), but 37 C.F.R. § 1.83(a) is subject to 37 C.F.R. § 1.81, which only requires a drawing "where necessary for the understanding of the subject matter sought to be patented". In view of the specification disclosure, and the Figures showing a circular disc (which is only a special form of the elliptical equations, it is respectfully submitted that no other drawing is necessary for understanding the claimed subject matter of claim 11. It is therefore respectfully requested that the drawings objections be withdrawn in view of the foregoing.

With respect to paragraph five (5), claims 22 to 24 and 26 were rejected as indefinite under the second paragraph of 35 U.S.C. § 112.

While the rejections may not be agreed with, to facilitate matters, claims 22, 23 and 26 were canceled without prejudice. As to claim 26, it was rewritten, and included in claim

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19. As to claim 25, it now provides that the disc is elliptically shaped, which should obviate the indefiniteness rejection as to claim 25. It is therefore respectfully requested that the indefiniteness rejections be withdrawn.

With respect to paragraph seven (7), claims 19 to 21, 26 to 29, 33, 35 and 37 were rejected under 35 U.S.C. § 102(b) as anticipated by Abe, Japanese Patent No. 02209002.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As to the “Abe” reference, it is respectfully submitted that this reference simply does not identically describe (or even suggest) the claim features of a “*first electrically conducting disc including a recess* and that is offset from the electrically conducting base area, the first electrically conducting disc being connected at an outside edge thereof to the electrically conducting base area by the at least one first electrically conducting web” and “*a second electrically conducting disc situated above the recess* and connected at an outside edge thereof to the first electrically conducting disc by the at least one second electrically

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conducting web”. For this reason alone, it is respectfully submitted that claim 19 is allowable.

To better clarify this aspect of the claimed subject matter, however, claim 19 now provides that the “*second electrically conducting disc has approximately a same area as that of the recess of the first electrically conducting disc.*” As explained at page one of the present application, the use of this recess makes it possible to implement a cascaded slotted antenna which requires only a single common feed via the antenna conductor, so that it is possible to manufacture a radio antenna for two or more frequency ranges in an efficient and space-saving design.

In contrast, it is respectfully submitted that the “Abe” reference simply does not identically describe a first disc having a recess that is approximately of the same area as a second disc, so as to provide the benefits of the presently claimed subject matter. In fact, the Figures of “Abe” show two separate coaxial conductors, one for each of the plates, unlike the presently claimed subject matter.

It is therefore respectfully submitted that claim 19 is allowable, as are all of its dependent claims.

With respect to paragraph nine (9), claims 22 to 25, 30, 31 and 34 were rejected under 35 U.S.C. § 103(a) as obvious over the “Abe” reference.

As regards the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). The prior art simply does not address the problems met by the subject matter of any of the rejected claims.

These claims depend from allowable claim 19, and are therefore allowable for the same reasons as claim 19. Also, claims 22, 23 and 25 were canceled for the reasons explained above. It is therefore respectfully requested that the obviousness rejections be

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withdrawn, since the remaining rejected claims are allowable for the same reasons as claim 19, from which they depend.

Accordingly, claims 19 to 21, 24 and 27 to 37 are allowable.

CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 19 to 21, 24 and 27 to 37 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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